

REMARKS

The Amendments

Claim 5 is amended to correct the obvious informality noted in the Office Action. Support for the narrower range which does provide a limitation from claim 1 is found in the specification at page 7, line 2, for example. The amendments do not narrow the broadest scope of the claims.

It is submitted that the above amendment would put the application in condition for allowance or materially reduce or simplify the issues for appeal, since it renders moot the claim objection. The amendment does not raise new issues or present new matter and does not present additional claims. The amendment has been made to correct the obvious error noted in the Office Action. It was not earlier presented because this error just came to light in the Office Action. Accordingly, it is submitted that the requested amendments should be entered.

The Restriction Requirement

Applicants maintain their traversal of the restriction requirement since the basis alleged for the requirement is not relevant to supporting restriction. The fact that the methods for preparing the compositions are merely a mixing of the components together does not support a restriction requirement. Applicants do not dispute that mixing, in general, was well known in the art. But the claims require mixing of a novel compound into a composition, which was not known in the art. The knowledge of mixing, in general, does not support either that (1) the process can be used to make other materially different products or (2) the product can be made by a materially different process, for the reasons previously set forth. Mixing of different components for making a materially different product is not using applicants' claimed process for such. It is further noted that claim 13 is more than merely mixing, i.e., it requires reactions for making the claim 1 compound. Thus, the reasoning in the Office Action does not support restricting the claim.

Further, it is urged that, if the restriction is maintained, there should at least be an indication that the method claims would be rejoined into the application if the general composition claim 1 is found allowable. The reasoning of In re Ochiai, 37 USPQ2d 1127 (Fed.

Cir. 1995); and In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996); and the Commissioner's notice thereon dated February 28, 1996, printed in 1184 OG 86; applies clearly to this application. Therein, it was stated that non-elected process claims which depend from or otherwise include the limitations of allowed product claims will be rejoined and included in the examination of the application upon allowance of the product claims. The reasoning for this is that if the composition is found novel and nonobvious, it is evident that the method for mixing the components to obtain the composition or reacting methods for making the formula I component would necessarily also be novel and nonobvious, i.e., if the composition is novel and nonobvious, there is no motivation to one of ordinary skill in the art to select to make such a composition for mixing.

For the above reasons, it is urged that the restriction of Group II from Group I should be withdrawn or that, at least, indication of eventual rejoinder be stated. Since it is believed the claims are, at least, appropriate for misjoinder, the non-elected claims are not canceled.

The Claim Objection

The objection to claim 5 is rendered moot by the above amendment thereto.

The Rejection under 35 U.S.C. §112

The rejection of claim 1 under 35 U.S.C. §112, second paragraph, is respectfully traversed. The phrase in question is the first alternative of the proviso reciting: "at least 3 radicals from R¹ to R⁷ are OH and that at least 2 pairs of -OH groups in the molecule are located at positions on a ring adjacent to one another" (emphasis added). The Examiner is correct that "at least 2 pairs of -OH groups" means 4 -OH groups but this is not inconsistent with the other requirement that at least 3 radicals from R¹ to R⁷ are OH. The requirement for the "at least 2 pairs of -OH groups" pertains to "in the molecule," i.e., in the entire molecule of formula I. The at least 3 radicals being -OH refers only to the particular groups R¹ to R⁷. The further -OH groups for the adjacent pairs can be met by groups other than R¹ to R⁷, so there is no inconsistency. For example, the two requirements would be met if R¹, R², R⁵ and R⁹ were -OH since three of R¹ to R⁷ would be -OH (i.e., R¹, R², and R⁵) and two adjacent pairs would be met

by the R¹/R² and R⁵/R⁹ pairs. In view of the above, it is believed that it should now be clear that the claim language is not inconsistent or indefinite.

The Rejection under 35 U.S.C. §103

The rejection of claims 1-11 and 18 under 35 U.S.C. §103, as being obvious over Ley (U.S. Patent No. 6,265,611) in view of Prendergast (WO 01/03681) and further in view of Jensen (U.S. Patent No. 2,550,255) is respectfully traversed.

Applicants respectfully submit that the allegation in the Office Action that applicants' previous reply was insufficient because it merely attacks the references individually is not an accurate reflection of applicants' previous reply. Applicants clearly addressed why one of ordinary skill in the art would not have been motivated to combine the reference teachings in a manner supporting the rejection. The Office Action even notes (page 6, second paragraph) that applicants made such arguments. Applicants are not barred from also discussing what the individual references teach and such additional discussion does not make their argument incorrect or less convincing. To the contrary, the individual teachings of the references must be considered to know whether there is motivation to combine them and, if combinable, what such combination would suggest. Applicants did clearly address the combined teachings of the prior art and, accordingly, the Keller and Merck & Co. case law cannot be relied upon to discount applicants' arguments.

Applicants maintain and reassert their arguments that there is no motivation to combine the reference teachings in the manner suggested to support the rejection of the instant claims.

Of the three cited references, only Prendergast provides any suggestion of flavonoid compounds such as of applicants' formula I. But there is no suggestion to use such a compound in a composition having anti-oxidant properties. Ley provides no suggestion to one of ordinary skill in the art to use the Prendergast formula 1 compounds in their anti-oxidant compositions. To the contrary, Ley teaches one of ordinary skill in the art to use hydroxymandelic acid amides, which are monocyclic amides (see formula I at col.1), to provide an anti-oxidant effect. These monocyclic amides are completely chemically distinct from flavonoid compounds, for example, those of Prendergast's formula 1 and, therefore, would not provide any suggestion that

Prendergast's compounds would have any anti-oxidant effect or motivate one of ordinary skill in the art to use Prendergast's compounds in an anti-oxidant composition.

The very general disclosure in Ley that unspecified bactericides or fungicides can optionally be used in its compositions does not provide sufficient motivation to one of ordinary skill in the art to make the specific combination of the compounds of Prendergast's formula 1 into the Ley compositions. Ley's disclosure on this point is a very broad shotgun-type recitation, i.e.:

The cosmetic and dermatological preparations according to the present invention can comprise cosmetic auxiliaries and additives, as are customarily-used in such preparations, e.g., preservatives, bactericides, fungicides, virucides, light filter substances, active ingredients with a cooling action, plant extracts, antiinflammatories, substances which promote wound healing, skin-lightening agents, skin-coloring agents, perfumes, antifoams, dyes, pigments which have a coloring action, thickeners, surface-active substances, emulsifiers, emollients, moisturizers and/or humectants, fats, oils, waxes or other customary constituents of a cosmetic or dermatological formulation, such as alcohols, polyols, polymers, foam stabilizers, electrolytes, organic solvents, silicone derivatives or chelating agents.

Such disclosure hardly provides one of ordinary skill in the art the necessary motivation to one of ordinary skill in the art to go to any reference which discloses any compound which may fall within these broad classes and select a specific such compound to combine in their compositions. The shotgun disclosure of Ley is far too remote to suggest to one of ordinary skill in the art use of any particular compound. The suggestion to one of ordinary skill in the art is made even further remote by the fact that the bactericide or fungicide property disclosed by Prendergast for its formula 1 compounds is only a remote secondary property. The primary properties Prendergast discloses for its compounds are anti-viral or anti-parasitic. The disclosure of other possible uses at the bottom of page 33 is, again, another shotgun-type disclosure lacking specificity. Even if one of ordinary skill in the art were motivated from Ley to pick out a specific bactericide or fungicide – from amongst all the other auxiliaries Ley broadly describes – one of ordinary skill in the art would not have been motivated to select a compound of Prendergast's formula 1 which discloses bactericidal and fungicidal properties only as secondary properties. There are also no teachings by which one of ordinary skill in the art would have a reasonable expectation that the Prendergast compounds would be compatible in an anti-oxidant

composition of Ley and would be useful in providing any desired effect.

The fact that each of Ley and Prendergast have remote teachings regarding bactericides and fungicides does not support the application of the cited Kerkhoven decision (page 6, third and fourth paragraph, of the Office Action). In Kerkhoven there were two references each teaching a specific set of compounds for the same specific property and thus it was found that a combination of two such specific compounds would be obvious to have the specific property. The facts here are distinct. Ley does not disclose any particular compounds as bactericides or fungicides. It merely provides a broad disclosure to use other additives in its compositions which might include unspecified bactericides or fungicides. This teaching fails to provide motivation to one of ordinary skill in the art to combine any particular bactericide or fungicide with the Prendergast compounds. Ley does not teach that the monocyclic amides disclosed therein are bactericides or fungicides, thus, there is no motivation under the Kerkhoven decision to combine such compounds with the flavonoids of Prendergast.

The combination of the teachings of Jensen add nothing to support motivation of using the Prendergast compounds in an anti-oxidant compositions such as that of Ley. Jensen admits that they do not even know what compounds are in its compositions for food preservatives (see col. 1, lines 26-33). Thus, it provides no suggestion to one of ordinary skill in the art to use specifically the compounds of Prendergast's formula 1 in the compositions of Ley.

Applicants respectfully submit that the only motivation for picking and choosing unrelated teachings from the three cited references comes from the impermissible use of applicant's own disclosure as a blueprint to reconstruct the claimed invention. Without applicant's own disclosure as a blueprint or guide, there is no direction in the art to combine the three cited references in a manner to arrive at applicant's invention or any suggestion of the desirability to do so. See Grain Processing v. American Maize, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988); and Orthopedic Equipment Co., Inc. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983). What else – other than applicants' own teachings – would motivate one skilled in the art pick and combine different teachings from:

- a reference teaching the use of monocyclic amides as anti-oxidants (Ley),
- a reference teaching the use of flavonoids as anti-viral or anti-parasitics

(Prendergast), and

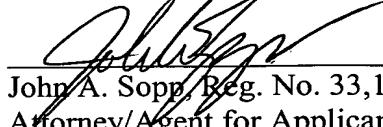
- a reference teaching the use of unknown extracts of avocado or pear pits as antibiotics (Jensen).

Each of the Ley, Prendergast and Jensen references are directed to diverse and nonanalogous art areas, and the case law regarding non-analogous art further supports an absence of motivation to combine these teachings. The two-step test for non-analogous art is set forth in In re Clay, 966 F.2d 656, 23 USPQ2d, 1058 (Fed. Cir. 1992). The first step inquires as to whether the references are in the same field of endeavor. In the present situation, they are not. As noted above, Ley discloses compounds for free-radical scavenging effects, Prendergast discloses structurally very distinct compounds primarily for antiviral and/or anti-parasitic effects, and Jensen discloses unidentified compounds as antibiotics. These are diverse fields of endeavor. The second step is to inquire whether the references are "reasonably pertinent to the same problem." Again, the problems are not the same. The problem in Ley was to find a compounds for anti-oxidant effects, the problem in Prendergast was to find an anti-viral or anti-parasitic compound and the problem in Jensen was to find a food-friendly antibiotic. Thus, it is urged that the cited references are in non-analogous areas and, therefore, lack of motivation is further shown.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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